

## REMARKS

Applicant has studied the Final Office Action dated January 23, 2006 and the Advisory Action dated June 8, 2006, and has made amendments to the claims. Claims 1, 3-9 are pending. Claims 1, 3 and 14 have been amended. Claim 2 has been canceled without prejudice. Claims 1, 3 and 14 are independent claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

### Amendments to the Claims

Claim 14 has been amended to address claim objections based on informalities and correct a typographical error and claim 3 has been amended to correct dependency in view of the cancellation of claim 2. It is respectfully submitted that the amendments have support in the application as originally filed and are not related to patentability.

### Objections to Claims

The Examiner objected to claim 14 due to an informality. Specifically, the Examiner asserted that "PDL" is an acronym that should be disclosed as "primary defect lists."

With this paper, claim 14 has been amended as suggested by the Examiner. It is respectfully submitted that the ground for objection has been overcome and it is respectfully requested that the Examiner withdraw the objection.

### § 102 Rejection

Claims 1-9 and 11-16 were rejected under 35 U.S.C. Section 102(e) as being anticipated by U.S. Patent No. 6,373,800 to Takahashi ("Takahashi"). This rejection is respectfully traversed.

A proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

With this paper, claim 2 has been canceled without prejudice. It is respectfully submitted that the rejection is moot with regard to claim 2 and it is respectfully requested that the rejection be withdrawn.

It is respectfully noted that the Examiner asserts, at paragraph 5 of the Office action, that the "prior art disadvantage is what applicant's has disclose in the specification as to be the subject matter of applicant's invention." Applicant respectfully disagrees with the Examiner's statement.

It is respectfully noted that the disadvantage of the prior art that the present invention addresses is the addition and expansion of spare areas until there is "a lack of sufficient spare area" and an optical disk is considered "useless." See specification at originally filed at page 9, ll. 4-8. It is respectfully submitted that the solution proposed by the present invention is adjusting the recording capacity of the recording medium based on

the number of un-slipped PDL entries and excluding a portion from the recording capacity corresponding to the number of un-slipped segments when there is "a lack of sufficient spare area."

It is respectfully noted that the Examiner asserts, at paragraph 4 on page 8 of the Office action, that Takahashi discloses "adjusting the recording capacity of the recording medium based on the number of un-slipped PDL entries" and cites col. 13, line 19, to col. 14, line 2, col. 14, ll. 11-22 and FIG. 8 as disclosing "adjust[ing] the recording capacity of the recording medium based on the error caused in the slipping displacement which is performed for the PDL, un-slipped defects, which are un-slipped PDL entries and further **adding/reserving/assigning/expanding/creating etc. new spare areas** ... [and] clearly discloses excluding a portion from the recording capacity, in that the areas are part of the user area, or in an areas other than the user areas at the time of such **addition assignment/expansion/creation of the new spare areas.**" (emphasis added). Applicant respectfully disagrees with the Examiner's interpretation of Takahashi.

It is respectfully submitted that the "addition assignment/expansion/creation of the new spare areas" cited by the Examiner in Takahashi is the very disadvantage of the prior art that the present invention addresses in that this "addition assignment/expansion/creation of the new spare areas" results in an optical disk being considered "useless" if there is "a lack of sufficient spare area." It is further respectfully submitted that the solution proposed by the present invention, specifically the adjusting the recording capacity of the recording medium based on the number of un-slipped PDL entries, in claims 1 and 4 and excluding a portion from the recording capacity corresponding to the number of un-slipped segments in claims 7 and 14, is not disclosed

in Takahashi.

It is respectfully submitted that, even under the Examiner's interpretation of Takahashi, the recording capacity is not adjusted nor are any portions of the recording capacity excluded according to the number of un-slipped entries or segments. It is respectfully submitted that Takahashi discloses that the recording capacity is not adjusted, but rather **maintained** by "addition assignment/expansion/creation of the new spare areas" and, therefore, is susceptible to the disadvantage of the prior art whereby an optical disk is considered "useless" due to "a lack of sufficient spare area" when no additional area exists that can be "added assigned/expanded/created." It is further noted Takahashi discloses that "the defective sector is considered as a non-existing sector" and that the "defective sectors are slipped" or, in other words, that the portions of the recording capacity that are excluded is based on the portions that are defective or that are "slipped," not the number of un-slipped segments. Col. 7, ll. 56-63.

To sum up the above arguments, the present invention addresses the disadvantage of the prior art in that the spare area is increased until there is insufficient spare area. The present invention, on the other hand, determines if an error occurs due to insufficient spare area in comparison to the number of un-slipped defective areas and adjusts the recording capacity according to the number of portions that are not able to be slipped due to the lack of sufficient spare area rather than maintaining the recording capacity of the disk at the risk of rendering the disk unusable and, thereby, enables a disk that would be unusable according to prior art methods to remain usable.

Therefore, it is respectfully asserted that independent claims 1, 4, 7 and 14 are allowable over the cited reference. It is further respectfully asserted that claim 3, which

depends from claim 1, claims 5 and 6, which depend from claim 4, claims 8, 9 and 11-13, which depend from claim 7, and claims 15 and 16, which depend from claim 14, also are allowable over the cited reference.

## CONCLUSION

In view of the above remarks, Applicant submits that claims 1, 3-9 and 11-16 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,  
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Date: June 23, 2006

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